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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/643,288	08/20/2003	Francis Luca Conte	23FLC31	4031

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EXAMINER

ROWAN, KURT C

ART UNIT	PAPER NUMBER
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3643

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/643,288

Applicant(s)

CONTE, FRANCIS LUCA

Examiner

Kurt Rowan

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3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 28 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 17 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 17, it is not clear if the elastic lash is used to launch the elongate rod or if the rod is swung to kill insects with the elastic lash or if the elongate rod is used to launch the lash and if so how ?

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopp for the same reasons stated in the first Office Action.

The patent to Kopp shows an insect swatter having an elongate rod 2 having a proximal end and a distal end. Kopp shows an elastic lash 5 and having a proximal end 4 fixedly joined to the distal end of the rod and an opposite distal end sized for being

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elastically stretched from the rod distal end to adjacent said rod proximal end so that release of said lash contracts the lash for swatting the distal end against an insect.

Kopp shows all of the elements recited with the exception of two rubber bands being joined together. Kopp shows one rubber band. However, given one rubber band, it would have been obvious to employ two for multiplied effect. See *In re Harza*, 124 USPQ 378. Further it would have been obvious to join the rubber bands together to increase the range of the weapon. In reference to claim 3, Kopp shows a latch 6 and means 9 for selectively releasing the latch. Does applicant wish to invoke 35 USC 112, sixth paragraph? In reference to claims 2 and 4, Kopp shows all the method steps recited.

3. Claims 5-9, 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopp as applied to claims 1-4 above, and further in view of Watkins for substantially the same reason stated in the first Office Action.

The patents to Kopp and Watkins show insect swatters. Kopp has been discussed above and does not show a latch pivotally joined to the handgrip. Kopp shows a handgrip 1. The patent to Watkins shows a gun handgrip 12 joined to the proximal end of the rod B and having a latch 18 pivotally joined to the handgrip. In reference to claims 5 and 18, it would have been obvious to provide Kopp with a pivoted latch as shown by Watkins for the purpose of providing easier cocking. In reference to claims 6 and 8, both Kopp and Watkins show stretching the lash, latching the distal end of the lash to the latch, gripping the handgrip to aim the rod distal end at an insect (see Fig. 1 of Kopp), and pulling the trigger to release the latch to contact the lash for swatting the

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insect. In reference to claim 7, Watkins shows a keyhole slot 34. Watkins shows one rubber band connecting the slot to the latch, but it would have been obvious to employ two rubber bands for the same reasons stated above. In reference to claim 9, Watkins shows the latch extending upwardly from the handgrip and keyhole slot 18 extending open downwardly in a direction opposite the upward extension of the latch. Watkins shows the lash 14 extending upwardly from the keyhole slot to the latch in Fig. 2.

4. Claims 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopp in view of Watkins as applied to claims 5-11 above, and further in view of Stone for substantially the same reasons stated in the first Office Action.

The patents to Kopp and Watkins have been discussed above. The patent to Stone shows a rubber band gun having a trigger 22, a latch 30, as part of the hammer, for holding rubber band 33. Stone shows a spring 27 connect to the trigger and the part of the barrel 10 which is connected to handgrip 17. In reference to claim 10, Kopp and Watkins do not show a pivot able latch, but the patent to Stone shows a latch 30, 37 that pivots between a cocked position as shown in Fig. 3 and a fired position as shown in Fig. 2. It would have been obvious to provide the rubber band gun of Kopp as modified by Watkins with a pivoted latch as shown by Stone since merely one latch is being substituted for another and the function is the same noting no stated problem is solved. In reference to claim 11, none of Kopp, Watkins or Stone show a thumb grip, but it would have been obvious to employ a thumb grip to make cocking easier. The examiner takes Judicial Notice that thumb grips for triggers are old and well known in the art. In reference to claim 12, Stone shows a spring 27 to return the trigger for the

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purpose of returning the trigger to a cocked position. In reference to claim 13, the combination of Kopp as modified by Watkins and Stone envisions the method steps in the claim, In reference to claim 14, the combination of Kopp as modified by Watkins and Stone also envisions that the cocked length is selected for stretching the rubber band or lash to about its maximum stretchable length without breaking for the purpose of getting maximum range from the swatter. In reference to claim 15, the combination does not recite that the cocked length is at least three times greater than the unstretched length of the lash but it would have been obvious to employ this length since the definition of an elastic material is one that stretches three times its original length. In reference to claims 16, 19, 20, it would have been obvious to employ first and second bands having equal length with the knot midway along the cocked length since the function is the same and no stated problem is solved.

### ***Response to Arguments***

5. Applicant's arguments filed Sept. 28, 2004 have been fully considered but they are not persuasive. Applicant argues that the three basic criteria must be provided by the examiner in establishing a prima facie case for obviousness. First evidence for the suggestion or modification, second, there must be a reasonable expectation for success and third the references must teach or suggest all of the claim limitations. There is evidence for the modification as found in re Harza. There clearly is a reasonable expectation for success since if one rubber band kills an insect, why would not two rubber bands kill an insect. Thirdly, the references suggest all of the claim limitations since with Harza suggesting employing more than one of an item for multiplied effect.

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This would encompass both having two rubber bands side by side and two rubber bands connected lengthwise. Both usages have advantages. In the first case, the rubber bands would form a wider projectile with more mass which would be effective for killing larger insects. In the second case, again the larger mass would be more effective for killing bigger insects and also, the two rubber bands connected in series would allow for different sized rubber bands to be used such as in the case where a user runs out of rubber bands of the desired size. Several smaller rubber bands could be employed with the same function as one larger one. This is the nexus between the art of record, the case law and the claims of the present invention. Hence, one skilled in the art would have found it obvious to employ two or more shorter rubber bands to replace one longer one. Applicant has not submitted any evidence that one rubber band functions any different than two or more rubber bands connected together. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). As to there not being a nexus between the claims and *In re Harza*, In response to applicant's argument that two rubber bands would not result in the claimed invention, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary

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reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. See the discussion of two or more rubber bands versus one rubber band, above. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.



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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Rowan whose telephone number is 703 308-2321. The examiner can normally be reached on Monday-Thursday 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Poona can be reached on 703 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kurt Rowan  
Primary Examiner  
Art Unit 3643

KR